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TECHNOLOGY CENTER 2100

In re Application of:
Endo, et al.
Application No. 09/940,982
Filed: August 29, 2001
For: Tamper Resistance Device

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed March 7, 2007 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require entry and consideration of the supplemental amendment of November 24, 2006.

The petition is **DISMISSED**.

File History

Advisory Action Mailed out October 30, 2006 indicating non-entry of the after final amendment submitted October 16, 2006.

A proper RCE was filed with indication to enter October 16, 2006 amendment.

On November 24, 2006 a supplemental amendment adding claims was filed.

On February 20, 2007 in the non-final office action the office indicated that the amendment of November 24, 2006 was not entered as it was not clearly limited to the responses provided for by 37 CFR 1.111(a)(2)(i).

The petition argues that the preliminary amendment of November 24, 2006, is not a "supplemental reply", the entry of which is provided for in 37 CFR 1.111(a)(2). That paragraph states, "A reply that is supplemental to a reply that is in compliance with 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section". The "reply" is the reply mentioned in the title of 1.111, "Reply by applicant or patent owner to a non final Office Action." The preliminary amendment by contrast, did not itself reply to any non-final office action and was not supplemental to a reply to a non-final office action. Indeed, the prior Preliminary amendment with the RCE is a submission required by 37 CFR 1.114 and not a "reply". It appears then that the preliminary amendment is not specifically governed by any rules under 37 CFR. However petition submits that the amendment in question is more similar

to a preliminary amendment filed after a new application than as a supplemental reply to a non-final office action.

The Law

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a) (1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) Supplemental replies . (i) **A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section.** The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (e.g., typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

§ 1.114 Request for continued examination.

- (a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:
- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
 - (2) Abandonment of the application; or
 - (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
- (b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.
- (c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. **If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.**
- (d) If an applicant timely files a submission and fee set forth in § 1.17(e), **the Office will withdraw the finality of any Office action and the submission will be entered and considered.**

§ 1.115 Preliminary amendments.

- (a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.

A review of the record and the law indicates that that the November 24, 2006 amendment was a supplemental reply because a proper RCE in an application finally rejected includes a submission that complies with 37 CFR 1.111. See 37 CFR 1.114(c) supra. Thus, the November 8, 2006 amendment is the first reply and the November 24, 2006 amendment would be a supplemental reply. 37 CFR 1.111(a)(2) states that supplemental replies will not be entered as a matter of right. The November 24, 2006 amendment is not a preliminary amendment as 37 CFR 1.115 states that a preliminary amendment is an amendment that is received in the office before the mail date of a first office action. A proper RCE lifts the finality of the previous office action and does not vacate the previous office actions. Therefore, the office actions mailed out in this application on October 3, 2005 and May 8, 2006 were before the November 24 2006 amendment. Therefore the non-entry and consideration of the supplemental amendment was proper.

The petition is **DISMISSED**.

The period for response continues to run from the February 20, 2007 office action and claims 1-8 are pending. If petitioner wants the November 24, 2006 non entered amendment considered a continuation application could be filed or a new amendment could be submitted with the

response to the outstanding office action. These newly submitted claims as with any newly submitted claims would be looked at to see if an election by original presentation would be proper.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO (2) MONTHS from the mailing date of this decision.

Any inquiry concerning this decision should be directed to Tod Swann at (571) 272-3612.



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